REMARKS

Claim Rejections

Claims 2 and 8 are rejected under 35 U.S.C. § 112, second paragraph. Claims 1-5, 7-13, 15-19, 21 and 23 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Eintracht et al. (U.S. 6,687,878). Claims 20 and 22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Eintracht et al. in view of Mandri (U.S. 6,549,751). Claims 6, 14 and 24 are rejected under 35 U.S.C. §103(a) as being unpatentable over Eintracht et al. in view of Mogul et al. (U.S. 6,243,761).

Drawings

It is noted that the Examiner has accepted the drawings as originally filed with this application.

New Claims

By this Amendment, Applicant has canceled claims 1-24 and has added new claims 25-43 to this application. It is believed that the new claims specifically set forth each element of Applicant's invention in full compliance with 35 U.S.C. § 112, and define subject matter that is patentably distinguishable over the cited prior art, taken individually or in combination.

New claims 25-37 are directed toward a method for note recording contents of a web page through an internet, which comprises the steps of: transmitting a file operation object, an asynchronous object, a medium play object, and a note record object of the web page to a reader utilizing a server (S31), the reader and the server being connected to the internet; establishing a note record folder, a picture folder, and a medium folder on the reader utilizing the file operation object (S33); displaying the web page in a browser of the reader (S34); and creating a note record file in the reader by selecting note record contents of the web page that have been transmitted to the reader (S43, S53, S63) and saving the note record file in the note record folder utilizing the note record object (S36).

New claims 38-43 are directed toward a server for note recording contents of a web page on a reader (200) through an internet (300) comprising: central

processing unit (101); a user interface (102); a communications interface (103); and a memory (110) connected to the central processing unit, the user interface, and the communications interface and having: an operating system (111); a communication access procedure (112); a web server procedure (113); and a note record object (124) creating a note record file (125) in the reader having a note recording capability when note record contents of the web page are selected by the reader and saving the note record file.

The primary reference to Eintracht et al. teaches synchronizing/updating local client notes including a notes client for creating, editing, deleting, retrieving, and storing notes.

Eintracht et al. do not teach transmitting a file operation object, an asynchronous object, a medium play object, and a note record object of the web page to a reader utilizing a server; establishing a note record folder, a picture folder, and a medium folder on the reader utilizing the file operation object; creating a note record file in the reader by selecting note record contents of the web page that have been transmitted to the reader and saving the note record file in the note record folder utilizing the note record object; a note record object creating a note record file in the reader having a note recording capability when note record contents of the web page are selected by the reader and saving the note record file; the memory includes a file operation object establishing a note record folder, a picture folder, and a medium folder on the reader when the file operation object is down loaded to the reader; nor do Eintracht et al. teach the memory includes an asynchronous object asynchronously transmitting at least one picture and at least one medium object of the web page to the reader, saving the at least one picture in a picture folder and the at least one medium object in a medium folder in the reader when the asynchronous object is down loaded to the reader.

The secondary reference to Mandri teaches a multimedia educational system and is cited form teaching a software program for an e-book and computer assisted instruction.

Mandri does not teach transmitting a file operation object, an asynchronous object, a medium play object, and a note record object of the web page to a reader utilizing a server; establishing a note record folder, a picture folder, and a medium

folder on the reader utilizing the file operation object; creating a note record file in the reader by selecting note record contents of the web page that have been transmitted to the reader and saving the note record file in the note record folder utilizing the note record object; a note record object creating a note record file in the reader having a note recording capability when note record contents of the web page are selected by the reader and saving the note record file; the memory includes a file operation object establishing a note record folder, a picture folder, and a medium folder on the reader when the file operation object is down loaded to the reader; nor does Mandri teach the memory includes an asynchronous object asynchronously transmitting at least one picture and at least one medium object of the web page to the reader, saving the at least one picture in a picture folder and the at least one medium object in a medium folder in the reader when the asynchronous object is down loaded to the reader.

The secondary reference to Mogul et al. teaches a method for dynamically adjusting multimedia content of a web page and is cited for teaching media play, and an electronic dictionary and a personal digital assistant.

Mogul et al. do not teach transmitting a file operation object, an asynchronous object, a medium play object, and a note record object of the web page to a reader utilizing a server; establishing a note record folder, a picture folder, and a medium folder on the reader utilizing the file operation object; creating a note record file in the reader by selecting note record contents of the web page that have been transmitted to the reader and saving the note record file in the note record folder utilizing the note record object; a note record object creating a note record file in the reader having a note recording capability when note record contents of the web page are selected by the reader and saving the note record file; the memory includes a file operation object establishing a note record folder, a picture folder, and a medium folder on the reader when the file operation object is down loaded to the reader; nor do Mogul et al. teach the memory includes an asynchronous object asynchronously transmitting at least one picture and at least one medium object of the web page to the reader, saving the at least one picture in a picture folder and the at least one medium object in a medium folder in the reader when the asynchronous object is down loaded to the reader.

Even if the teachings of Eintracht et al., Mandri, and Mogul et al. were combined, as suggested by the Examiner, the resultant combination does not suggest:

1) regarding claims 25-37, transmitting a file operation object, an asynchronous object, a medium play object, and a note record object of the web page to a reader utilizing a server; establishing a note record folder, a picture folder, and a medium folder on the reader utilizing the file operation object; nor does the combination suggest creating a note record file in the reader by selecting note record contents of the web page that have been transmitted to the reader and saving the note record file in the note record folder utilizing the note record object; and

2) regarding claims 38-43, a note record object creating a note record file in the reader having a note recording capability when note record contents of the web page are selected by the reader and saving the note record file; the memory includes a file operation object establishing a note record folder, a picture folder, and a medium folder on the reader when the file operation object is down loaded to the reader; nor does the combination suggest the memory includes an asynchronous object asynchronously transmitting at least one picture and at least one medium object of the web page to the reader, saving the at least one picture in a picture folder and the at least one medium object in a medium folder in the reader when the asynchronous object is down loaded to the reader.

It is a basic principle of U.S. patent law that it is improper to arbitrarily pick and choose prior art patents and combine selected portions of the selected patents on the basis of Applicant's disclosure to create a hypothetical combination which allegedly renders a claim obvious, unless there is some direction in the selected prior art patents to combine the selected teachings in a manner so as to negate the patentability of the claimed subject matter. This principle was enunciated over 40 years ago by the Court of Customs and Patent Appeals in In re Rothermel and Waddell, 125 USPQ 328 (CCPA 1960) wherein the court stated, at page 331:

> The examiner and the board in rejecting the appealed claims did so by what appears to us to be a piecemeal reconstruction of the prior art patents in the light of appellants' disclosure. ... It is easy now to attribute to this prior art the knowledge which was first

made available by appellants and then to assume that it would have been obvious to one having the ordinary skill in the art to make these suggested reconstructions. While such a reconstruction of the art may be an alluring way to rationalize a rejection of the claims, it is not the type of rejection which the statute authorizes.

The same conclusion was later reached by the Court of Appeals for the Federal Circuit in <u>Orthopedic Equipment Company Inc. v. United States</u>, 217 USPQ 193 (Fed.Cir. 1983). In that decision, the court stated, at page 199:

As has been previously explained, the available art shows each of the elements of the claims in suit. Armed with this information, would it then be non-obvious to this person of ordinary skill in the art to coordinate these elements in the same manner as the claims in suit? The difficulty which attaches to all honest attempts to answer this question can be attributed to the strong temptation to rely on hindsight while undertaking this evaluation. It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit. Monday morning quarterbacking is quite improper when resolving the question of non-obviousness in a court of law.

In <u>In re Geiger</u>, 2 USPQ2d, 1276 (Fed.Cir. 1987) the court stated, at page 1278:

We agree with appellant that the PTO has failed to establish a *prima facie* case of obviousness. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination.

Applicant submits that there is not the slightest suggestion in either Eintracht et al., Mandri, or Mogul et al. that their respective teachings may be combined as suggested by the Examiner. Case law is clear that, absent any such teaching or suggestion in the prior art, such a combination cannot be made under 35 U.S.C. § 103.

Neither Eintracht et al., Mandri, nor Mogul et al. disclose, or suggest a modification of their specifically disclosed structures that would lead one having ordinary skill in the art to arrive at Applicant's claimed structure. Applicant hereby respectfully submits that no combination of the cited prior art renders obvious Applicant's new claims.

Summary

In view of the foregoing amendments and remarks, Applicant submits that this application is now in condition for allowance and such action is respectfully requested. Should any points remain in issue, which the Examiner feels could best be resolved by either a personal or a telephone interview, it is urged that Applicant's local attorney be contacted at the exchange listed below.

Respectfully submitted,

Date: <u>March 8, 2005</u>   By: _____

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